

## REMARKS/ARGUMENTS

Claims 4,5,7-16, 18-21 and 23-28 are currently pending. Claims 4,5,7-16, 18-21 and 23-28 are rejected as anticipated by U.S. Patent Number 5,215,080 to Thomas, et. al. (hereinafter "Thomas"). By this amendment, independent claims 11, 13, and 15, and 16 are amended to provide that the rigid substrate is made out of a physical shock resistant material. Support for this limitation is found in the specification, page 9, line 28-30 wherein the specification reads:

A variety of materials may be used for the outer substrate, and similarly for the lining. Reversibly deformable material, but nevertheless shock resistant material, could be used as the outer substrate. Suitable materials include plastics including nylons...

Claim 16 is amended to recite a first rigid substrate. Support for this limitation is found on page 5, line 27.

### Applicant's Invention

Applicant's invention is a multi-component neck protection device designed to protect the wearer's neck while also allowing unimpeded access by emergency personnel to the neck.

The neck protector includes at least two *layers* or substrates. The first, and outer, substrate is impact-resistant, and can be made of fiberglass, wood, metal or Kevlar (see page 5, lines 28 of specification). This first substrate overlays a second reversibly deformable, or cushioning, substrate.

None of the art of record to date teaches this combination.

### **Anticipation Rejection in Light of Thomas**

Claims 4,5,7-16, 18-21 and 23-28 are rejected as anticipated by Thomas. Applicant respectfully disagrees.

Anticipation under 35 U.S.C. §102(b) requires “the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”<sup>1</sup> Applicants submit that Thomas does not disclose each and every element of the independent claims as now more clearly defined.

### Thomas Fails to Show Multiple Substrates

Applicant’s invention as currently claimed uses *two* substrates. A first, outer substrate and an inner cushioning substrate.

Thomas’s device consists of wet suit rubber and nylon pockets adapted to receive plastic baggies. Thomas does not disclose an outer impact resistant substrate (which per now amended claim 16 also must be rigid) overlaying a less pliable inner substrate

Nothing in Thomas confers the shock resistance of the outer substrate of the claimed invention.

### Thomas Teaches Away

#### From Free Hanging Feature

Thomas’s wet-suit material hugs the wearer to as to confer is thermal insulating qualities to the skin. This close adherence is designed to prevent temperature exchange between the covered skin of the user and the environment. As noted in the Wikipedia Wet Suit definition:

A wetsuit must have a snug fit to work efficiently; too loose a fit will allow water to escape from between the suit and the body, taking the body's heat with it.

As such, using wet suit material in the invented device would contravene one of its purposes which is to freely hang down the back of the neck (page 10, line 25) as a passive shock resistant shield, whereby the top of the device may be attached to the outside of a helmet or hat (page 11, lines 1-5). The free hanging feature of the device also allows for unimpeded examination of the neck

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<sup>1</sup> Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

area by emergency personnel (page 2, lines 21-23, page), and eliminates excessive contact pressure (page 3, lines 16-17) in case of such injury.

Along with this free-hanging feature, the device also allows a means for imparting heat or cold to the wearer. To wit, page 11 lines 12-14 of the specification state as follows:

"This is especially valuable for athletes and others concerned with heat build-up in warm climates or muscle/joint stiffness in cold climates."

As presently amended, the claims recite that the outer substrate is resistant to physical shocks and impacts. Examiner indicates that as shown in Figures 2, 7, and 8, Thomas teaches an impact resistant outer substrate. Applicant respectfully disagrees.

Figure 2 depicts an ice pack holder designed to be temporarily attached to the neck. Figures 2, 7 and 8 show the "second configuration of the icing system." Thomas Col. 3, Lines 57-58.

This "second configuration" is discussed in conjunction with Figures 7 and 8 in Col. 5, line 30 and onwards. As shown in Figure 7, the second configuration has an insulating layer 18' with a specific shape. Other elements include a single mating strap 12' and strip 16' attached to the textured side 19 of the insulating layer 18'. There are also compartments 33', 34', and 35', of various sizes. Bags 36 are inserted in the compartments.

These elements are designed to show the means in which the *shape* of the Thomas ice pack may be adapted for use on the neck region. Nothing in the discussion of the second configuration found in the figures 2, 7, 8 discusses using an impact and physical shock resistant outer layer.

Furthermore, while Thomas discloses at least three different alternatives of the invention, none of these three alternatives discloses an outer layer that is impact and physical shock resistant. Instead, the three alternatives differ in the placement of ice pack holders.

Thomas Cannot Be Combined With  
Other References to Result in an Outer  
Impact and Physical Shock Resistant Layer

In the current office action, the Examiner does not propose to combine Thomas with any other references. Nonetheless, Applicant respectfully submits that any combination involving Thomas must rely on a wet suit rubber based device.

Thomas extols the benefits of wet suit rubber and provides no alternatives for the main construction material. Thomas Col. 2, Lines 58-63. Furthermore, Thomas states that the device must allow “maximum mobility on the part of the user.” Thomas Col. 1, Lines 66-69.

Given that unhindered mobility is an integral purpose of Thomas, the use of a impact and physical shock resistant substrate contravenes the stated purpose of Thomas.

It is well established that a proposed combination cannot render the prior art unsatisfactory for its intended use.<sup>2</sup> Combining Thomas with another reference to arrive at the instant invention would disregard Thomas’ disclosure that wetsuit rubber is the primary material for the device and also that the device must not hinder movement.

As such, applicant respectfully submits that Thomas cannot be used to reject the instant invention either alone or in combination.

In light of the above, Applicant respectfully submits that the rejection in light of Thomas is obviated. Inasmuch as the sole reference cited against the instant application is Thomas, applicant respectfully submits that the current claims are allowable.

Applicant encloses payment (submitted via EFS-Web) for the required extension of time. The Office is authorized to charge any deficiency or credit any overpayment to the undersigned’s Deposit Account No. 501709.

An earnest attempt has been made hereby to respond to the June 25, 2009 Official Action in the above identified matter. Applicant submits that the application is now in condition for allowance. If the Examiner feels that a telephonic interview will

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<sup>2</sup> See MPEP §2143.01 and *In re Gordon*, 733 F.2d 900, USPQ 1125 (Fed. Cir. 1984).

expedite allowance, she is respectfully urged to contact the undersigned. Claims 4-5, 7-16, 18-21, 23-28 are pending. Issuance of the Notice of Allowance is hereby solicited.

Dated: December 14, 2009

Respectfully submitted,

**CHERSKOV & FLAYNIK**

/Szymon M. Gurda/

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Szymon M. Gurda  
Reg. No. 58,451